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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,147	01/16/2004	Lawrence I. Wechsler	W1000-24	7189

7590 02/23/2005

Lawrence I. Wechsler
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EXAMINER

NGUYEN, TRINH T

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/760,147

Applicant(s)

WECHSLER, LAWRENCE I.

Examiner

Trinh T Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1: A toy as shown in Figures 1 and 2.

Species 2: A toy as shown in Figures 4 and 5.

Species 3: A toy as shown in Figures 6 and 7.

Species 4: A toy as shown in Figure 8.

Species 5: A toy as shown in Figure 9.

Species 6: A toy as shown in Figure 10.

Species 7: A toy as shown in Figure 11.

2. Furthermore, if **Species 1** is selected then a further election is required to the following patentably distinct species of the claimed invention:

Species 1A: A toy as shown in Figure 3a.

Species 1B: A toy as shown in Figure 3b.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, it appears that claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

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is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. During a telephone conversation with Mr. Wechsler on 2/9/05 a provisional election was made without traverse to prosecute the invention of Species 2, claims 1-4, and 9-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5-8 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the

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list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 9-12, and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Willinger et al. (US 6,651,590) (please see a more detail Figure 22 of Willinger et al. attached with the Office Action for further explanation for the rejections of claims 1-4, 9-12, and 15-18).

For claim 1, Willinger et al. disclose a toy, comprising: a structural configuration including a portion thereof defining an animal restricted region; and said structural configuration including an other portion defining an animal access region.

For claim 2, Willinger et al. further disclose said animal restricted region is created by provision of structure at least partially physically shielding said animal restricted region from access by a mouth of the animal.

For claim 3, Willinger et al. further disclose said animal restricted region includes a handle graspable by a hand of a human user.

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For claim 4, Willinger et al. further disclose a toy which inhibits user hand contact with animal saliva deposited on a play toy during interactive play by the animal and the user, comprising: at least one structural portion being disposed in a position readily accessible by a mouth of the animal and by which the animal can hold the toy by retaining the at least one structural portion in the mouth; at least one hand-holdable portion grippable by the user; and a shielding portion arranged to at least partially discourage animal access to said at least one hand-holdable portion.

For claim 9, Willinger et al. further disclose said at least one structural portion includes members disposed in circumferentially spaced apart positions about a toy axis and radially spaced apart therefrom; said at least one hand-holdable portion is positioned radially inward of a outermost radial extent of said members.

For claim 10, Willinger et al. further disclose said members include at least three members at least a portion of each of the members extending longitudinally co-directional with said toy axis.

For claim 11, Willinger et al. further disclose said at least a portion of said three members which extend longitudinally are spaced apart circumferentially from one another by approximately equal angular intervals.

For claim 12, Willinger et al. further disclose said at least one hand-holdable portion includes at least one handle approximately aligned longitudinally with the toy axis; and radially outward portions of the members are extended outward from a center of the toy in an axial direction such that said radially outward portions extend past an axial

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position of an inwardmost end of the handle, thereby at least partially shielding the handle.

For claim 15, Willinger et al. further disclose the toy is formed integrally.

For claim 16, Willinger et al. further disclose the toy includes a resilient material.

For claims 17 and 18, it is noted that the method steps (i.e., "providing the toy with an animal access region..."; "providing the toy with an animal restricted region..."; "grabbing the animal restricted region..."; "making the toy available...") as claimed are inherently performed within Willinger et al.'s toy, since Willinger et al.'s toy has the specific structural configurations similar to the toy claimed by the applicant.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willinger et al. (US 6,651,590).

As described above, Willinger et al. lack the outermost edges of the members are shaped to collectively describe a generally spherical envelope. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the toy of Willinger et al. in whatever form or shape was desired or expedient, wherein no stated problem is solved by having the specific shape as claimed versus the shape taught by the prior art. Furthermore, a change in form or shape is generally recognized

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as being well known within the level to one of ordinary skill in the art depending on one's intended use.

For claim 14, Willinger et al. further disclose the toy is self-righting, such that when tossed onto a relatively horizontal support surface, the toy will come to rest with the at least one handle extending horizontally, and generally parallel with the support surface.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as cited on PTO-form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh T Nguyen whose telephone number is (703) 306-9082. The examiner can normally be reached on M-F (9:30 A.M to 6:00 P.M).

The examiner's supervisor, Teri Luu can be reached on (703) 305-7421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Trinh T. Nguyen', with a stylized, flowing script.

Trinh T Nguyen

Patent Ex.

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2/18/05

